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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/862,542	05/22/2001	Robert Alan Reeves	STEV-109	1268

7590

09/25/2003

ROBERT E. STRAUSS
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EXAMINER

CHANG, VICTOR S

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 09/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

Office Action Summary	Application No.	Applicant(s)	
	09/862,542	REEVES ET AL.	
	Examiner	Art Unit	
	Victor S Chang	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 6-19 is/are pending in the application.
- 4a) Of the above claim(s) 9-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 6-8, 16-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Examiner has carefully considered Applicant's amendments and remarks filed on 7/24/2003. Applicant's amendments to claims 1, 2 and 8, cancellation of claim 3, and newly added claims 18 and 19 have all been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-2, 6-8 and 16-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

More particularly, it is noted that the amended claim 1, lines 17-18 now recites in part "all said successive coats ... having melting temperatures less than said molding temperature" appears to be "new matter", which additionally renders the claims unduly broad and in excess of the Specification. Applicant has not pointed out ^{express} ~~apparent~~ or

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inherent support for the indicia coat having a melting temperature less than molding temperature in the originally submitted Specification and claims. Further, the Examiner would like to note that with all the coating layers now having melting temperature less than the molding temperature, the resultant label may also be not enabling, i.e., the label could be thermally unstable under the heated condition, especially the indicia layer could be distorted upon the removal of the carrier layer.

6. Claims 1-2, 6-8 and 16-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner suggests to change "and successive coats" at line 7 of claim 1 to -and having successive coats--, so as to clarify the instantly claimed invention.

Response to Amendment

7. While the newly amended claim 1 now recites appears to overcome the Markar reference by reciting "all said successive coats ... having melting temperatures less than said molding temperature", it should be noted that such amendment appears in excess of the disclosure, and also contains "new matter" as set forth above. Should Applicant withdraw the amendment, the Examiner would like to remind Applicant that the prior rejection under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Markar et al. (US 5908694) would be re-inserted, substantially for the reasons set forth in section 4 of Paper No. 12, together with the following additional observations.

With respect to Applicant's argument that "none skilled in the art would obviously expose a transfer having an adhesive layer containing up to 30% nitrocellulose to rotational molding temperature as that layer would not be stable under such temperature" (Remarks, page 7, first full paragraph), the Examiner notes that Markar expressly teaches that during the manufacturing the deposited layer is heated, causing the volatile component of the ink composition to evaporate and leaving only the non-volatile component to form layer 125. Further, it should be noted that such an assertion of what seems to follow from common experience is just an unsupported argument and not the kind of factual evidence that is required to rebut a *prima facie* case of obviousness. See MPEP § 2145.I.

With respect to Applicant's argument that "Since Markar et al print on a lacquer surface, there would be no purpose to substituting the Noguchi ink for the polyamide ink of Markar et al." (Remarks, page 7, second full paragraph), the Examiner repeats (see Paper No. 12, page 3) that Noguchi's invention is directed to an ink for heat transfer, and Noguchi teaches that it is known art that in order to prevent running and strike-through of the ink and to keep the printed image quality by adjustment of the ink formulation, a solid component like a wax and a polymeric compound is added to the ink with the dye component (column 2, lines 7-12). As such, it would have been obvious to one skilled in the art to modify Markar's heat transfer label with Noguchi's ink, motivated by the desire to prevent running of the ink under the heat transfer conditions.

With respect to Applicant's argument that Markar does not teach that "indicia as a direct, rather than mirror, image on the carrier" (Remarks, page 7, bottom paragraph),

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the Examiner notes that coating "indicia as a direct image" is not recited in any of the claims of the instant invention.

With respect to Applicant's argument the "the heat activated adhesive layer must be ... non-adhesive at ambient temperature, adhesive at the demolding temperature and stable at, and melt below, the molding temperature", the Examiner repeats (see Paper No. 12, page 3) that it is believed that selecting a heat-activatable adhesive layer with suitable melting temperature is either inherently disclosed, or an obvious optimization to one of the ordinary skill in the art.

With respect to Applicant's argument that "the indicia coat must be printed with indicia material in hydrocarbon wax" (Remarks, page 8, top paragraph), the Examiner again repeats that it would have been obvious to one skilled in the art to modify Markar's heat transfer label with Noguchi's ink, which contains hydrocarbon wax, motivated by the desire to prevent running of the ink under the heat transfer conditions.

For newly added claims 18 and 19, the Examiner notes that although Markar lacks an express teaching of using polyester film for carrier layer, it is believed that the use of an inherently transparent polyester film as a carrier layer for heat transfer is either inherently disclosed, or an obvious optimization to one skilled in the art of heat transfer label, motivated by the desire to obtain heat resistance under heat transfer conditions. Note also as evidence of the state of the art Hiatt et al. (US 6254970) which is directed to substrates for heat transfer labels. Hiatt teaches that it is known art that various substrates can be used as carrier layer of a heat transfer label, including polyester films, etc. (column 1, lines 30-37).

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8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 703-605-4296. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 703-308-2414. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

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VSC

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 1900-
1700

Daniel Zinker